REMARKS

The Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-22 are pending in this application.

Inappropriate Official Notice

The Examiner takes official notice and opines "an analog video cassette player and digital video recorder having an analog to digital converter and removable digital storage medium such as digital video cassette recorder are old and well know in the art." *see* the Current Action, pg. 4. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. The Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained. *see* M.P.E.P. § 2144.04(c); 37 C.F.R. 1.04(c)(2); *see also In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). The Applicant respectfully requests that the Examiner produce documentary evidence in support of his assertion of official notice. Otherwise the rejection of claims should be withdrawn.

Rejection Under 35 U.S.C. 103(a)

Claims 1, 3-6, 9-11, 14-19, and 21-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,365,313 to Menezes et al (hereinafter "Menezes").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without admitting that the second criteria is satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the first and third criteria.

Lack of Motivation

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In the Current Action, the Examiner sets forth the motivation for combining the suggested references as follows: "it would have been obvious...to incorporate an analog to digital converter to increase the flexibility of the system of Menezes and to increase the quality of the edited video signal...because...a digital video recorder has higher quality than the analog video recorder." *see* the Current Action, pg. 4. The Applicant respectfully points out that the Examiner's logic is faulty for at least two reasons. First, the Examiner's statement is circular; that is, the Examiner does nothing more than merely state that it would have been obvious to modify a reference to achieve a particular result. Second, the Examiner mistakenly assumes that the conversion of analog signals into digital data effectuates an improvement in the overall system. However, this is not the case. Rather, converting an analog signal into digital data requires the analog signal to be "sampled." During sampling, a "comb" operation is performed on the analog sample; as such, there is necessarily a loss of information during the conversion. As a result, modifying Menezes to include converting analog video output into digital data would not "increase the quality of the edited video signals" as the Examiner claims. No valid suggestion has been made as to why a combination of Menezes and an analog to digital converter is desirable. Therefore, the rejection of claim 1-23 should be withdrawn.

Failure to Teach Or Suggest All Claim Limitations

Claim 1 recites a key frame marker for inserting at least one marker into the digital data. In the Current Action, the Examiner points to Menezes, at col. 9, lines 30-41 to satisfy this limitation. *see* the Current Action, pg. 3. However, at this citation Menezes merely describes edit-in switch 82, edit-out switch 86 and mark enable switch 90 to be used so that data may be transferred from one display register to another in a particular section. *see* Menezes at col. 9, lines 34-39. Reference to Menezes shows that these switches, particularly the mark enable switch, are used to control the transfer of "position data" between source and destination switches. *see* Menezes at col. 8, lines 51-55. Further, "position data" represents the relative position of a first record medium (source medium) and a second record medium (destination medium). Transferring the position data between the first and second medium effectuates the transfer of signals between the first and second medium at an appropriate location along the second medium (i.e. when pre-selected positions of the second medium are reached). *see* Menez Abstract. As such, the switches cited by the Examiner do no more than synchronize or align the respective mediums so that recording begins at an appropriate time within the medium to receive the transferred signals. The Applicant respectfully submits, however, that transferring relative position data between a first and second medium is not the same as inserting a key frame marker. Put simply, nothing is "inserted." As shown, the Examiner's rejection fails to teach or suggest all limitations of Applicant's claimed invention. Therefore, the Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

Claims 3-6 and 9 depend from claim 1 and therefore inherit all limitations from claim 1. As such, claims 3-6 and 9 set forth limitations that are not taught or suggested by the Examiner's cited references. Therefore, claims 3-6 and 9 are allowable at least for the reasons set forth above with respect to claim 1.

Claims 2, 7-8, 12-13, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Menezes in view of U.S. Patent No. 6,591,058 to O'Connor et al (hereinafter "O'Connor").

However, claims 2, 7-8, 12-13, and 20 depend from claims 1, 10, and 19, respectively and thus inherit all limitations from their respective base claim. As set forth above, the

Examiner's propose combination with respect to claims 1, 10, 19 does not comport with 35 U.S.C. § 103(a). The inclusion of O'Connor does not cure the deficiencies in the Examiner proposed combination used to reject the base claims. Therefore, claims 2, 7-8, 12-13, and 20 are allowable at least for the reasons set forth above with respect to claims 1, 10, and 19. Therefore, the Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

Conclusion

In view of the remarks above, the Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10981001-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV482724225US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: January 5, 2006

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Respectfully submitted,

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